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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,185	11/26/2001	Mark Leslie White	27129/33783B	9922
4743	7590	05/23/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				CANELLA, KAREN A
ART UNIT		PAPER NUMBER		
		1642		

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/994,185	WHITE ET AL.
	Examiner	Art Unit
	Karen A. Canella	1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-17 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) 5-17 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## DETAILED ACTION

1. Claim 1 has been amended. Claims 1-17 are pending and under consideration.
2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
3. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
4. Claims 1-4 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of prior U.S. Patent No. 5,891,618. This is a double patenting rejection.
5. The rejection of claims 1-4 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U. S. Patent No. 5,891,618, claims 1-11 U. S. Patent No. 5,804,367 and claims 1 and 2 of U. S. Patent No. 5,484,705 is withdrawn in light of applicants Terminal Disclaimer.
6. The rejection of claims 1-4 and 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U. S. Patent No. 5,891,618, claims 1-11 U. S. Patent No. 5,804,367 and claims 1 and 2 of U. S. Patent No. 5,484,705 of U.S. Patent No. in view of the abstract of Gardener et al (Journal of Reproductive Medicine, 1977, Vol. 19, pp. 64-66) is withdrawn in light of applicants Terminal Disclaimer.
7. The rejection of claims 1-4 and 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U. S. Patent No. 5,891,618, claims 1-11 U. S. Patent No. 5,804,367 and claims 1 and 2 of U. S. Patent No. 5,484,705 of U.S. Patent No. in view of the abstract of Grobler et al (Gut, 1993 Oct, vol. 34, pp. 1384-1388) is withdrawn in light of applicants Terminal Disclaimer.

8. The rejection of claims 1-4 and 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U. S. Patent No. 5,891,618, claims 1-11 U. S. Patent No.5,804,367 and claims 1 and 2 of U. S. Patent No.5,484,705 of U.S. Patent No. in view of the abstract of Gelman et al (Radiology, 1977, Vol. 122, pp. 17-23) is withdrawn in light of applicants Terminal Disclaimer.

9. The rejection of claims 1-4 and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U. S. Patent No. 5,891,618, claims 1-11 U. S. Patent No.5,804,367 and claims 1 and 2 of U. S. Patent No.5,484,705 of U.S. Patent No. in view of the abstract of Cohen et al (QJM, 1982, Vol. 51, pp. 1-15) is withdrawn in light of applicants Terminal Disclaimer..

10. The rejection of claims 1-4 and 17 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U. S. Patent No. 5,891,618, claims 1-11 U. S. Patent No.5,804,367 and claims 1 and 2 of U. S. Patent No.5,484,705 of U.S. Patent No. in view of the abstract of Allwright et al (Clinical Nuclear Medicine, 1988, Vol. 13, pp. 506-508) is withdrawn in light of applicants Terminal Disclaimer.

11. The rejection of claims 1-5 and 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U. S. Patent No. 5,891,618, claims 1-11 U. S. Patent No.5,804,367 and claims 1 and 2 of U. S. Patent No.5,484,705 of U.S. Patent No. in view of the abstract of Hunt (Journal of Immunology, 1989) is withdrawn in light of applicants Terminal Disclaimer.

12. The rejection of claims 1-4 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U. S. Patent No. 5,891,618, claims 1-11 U. S. Patent No.5,804,367 and claims 1 and 2 of U. S. Patent No.5,484,705 of U.S. Patent No. in view of the abstract of Martin (Immunology, 1991, Vol. 73, pp. 123-125) is withdrawn in light of applicants Terminal Disclaimer.

13. Claims 5-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10 a.m. to 9 p.m. M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571)272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Karen Canella, Ph.D.

05/19/2005

*Karen A. Canella*  
KAREN A. CANELLA PH.D  
PRIMARY EXAMINER